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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,504

12/20/2004

Jaakko Rajaniemi

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EXAMINER

CHAI, LONGBIT

ART UNIT

PAPER NUMBER

2131

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/518,504	Applicant(s) RAJANIEMI, JAAKKO	
	Examiner Longbit Chai	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/20/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant's claim for benefit of Continuing Application priority date under 35 U.S.C. 120 is acknowledged.

The application is filed on 12/20/2004 but is a 371 of PCT/IB02/02423 case filed on 6/26/2002.

Preliminary Amendment

2. Examiner acknowledges Preliminary Amendment for the claims filed 12/20/2004. Applicants have cancelled claim 1 – 13 and added new claim 14 – 26. The submitted amendments have been entered and made of record. Presently, pending claims are 14 – 26.

Claim Objections

3. Claims 15 – 26 are objected to because of the following informalities: "A method" should be "The method". Appropriate corrections are required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 25 and 26 are rejected under 35 U.S.C. 101, because the claimed invention may be directed to software per se which is directed to non-statutory subject matter. Examiner notes for a system or an apparatus claim, at least one recited element must be hardware; however,

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the claim limitations such as accessing, authenticating, authorizing and indicating may be reasonably interpreted as being not limited to hardware elements and the claim may be merely directed to software per se as a non-statutory subject matter for a system claim.

Furthermore, claims 25 and 26 are rejected under 35 U.S.C. 101, because the cited claims are adapted to perform a method according to claim 14. Examiner notes that claim language such as “adapted to (or adaptable)” **merely suggests limitations or makes limitations optional to a certain extent**. In using claim language such as “adapted to (or adaptable)” applicant has not required steps to be performed or limited an apparatus to a particular structure (see MPEP 2106). Therefore, the cited claims fail to provide an invention with a useful, concrete and tangible result.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them specifically within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraph of 35 U.S.C. 102 that forms the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by McIntosh et al. (U.S. Patent 2003/0139180).

As per claim 14, McIntosh teaches a method of providing an accounting service in a mobile communication system, comprising the steps of:

accessing a chargeable functionality of said communication system by a user, by authenticating said user by authentication/authorization server (McIntosh : Page 7, Para [0067] Line 12 – 20), and

authorizing said access of said user by said authentication/authorization server (McIntosh : Page 7, Para [0067] Line 15 – 20); and

indicating, by said authentication/authorization server, a specific accounting server out of several possible ones dependent on the user, wherein said accounting server is physically separated from said authentication/authorization server (McIntosh : Page 10, Para [0096]).

6. Claims 14 – 17 and 19 – 23 are rejected under 35 U.S.C. **102(a)** as being anticipated by Ala-Laurila et al. (WO 10/76297 A1).

As per claim 14, Ala-Laurila teaches a method of providing an accounting service in a mobile communication system, comprising the steps of:

accessing a chargeable functionality of said communication system by a user (Ala-Laurila : Page 8, 2nd Para), by authenticating said user by authentication/authorization server (McIntosh : Page 12), and

authorizing said access of said user by said authentication/authorization server (Ala-Laurila : Page 12); and

indicating, by said authentication/authorization server, a specific accounting server out of several possible ones dependent on the user, wherein said accounting server is physically separated from said authentication/authorization server (Ala-Laurila : Page 12 Line 1 – 9: (a) an accounting server of an external telecommunication network is considered as physically separated from said authentication/authorization server (b) the user identity is used to generate billing data and sending the billing data to the corresponding accounting server).

As per claim 15, Ala-Laurila teaches said authentication/authorization server is in a home network of said user (Ala-Laurila : Page 7 Line 24 – 28 and Page 8 Line 21 – 26).

As per claim 16, Ala-Laurila teaches said chargeable functionality is a service provided in a visited network of said mobile communication system (Ala-Laurila : Page 7 Line 25 – 32 and Page 6 Line 17 – 20: the roaming service is considered as provided with a visited network that is different from the home network).

As per claim 17, Ala-Laurila teaches said chargeable functionality is a service of said mobile communication system (Ala-Laurila : Page 7 Line 30 – 32 and Page 6 Line 17 – 20).

As per claim 19, Ala-Laurila teaches said authentication/authorization server directly indicates said specific accounting server to said authentication/authorization client, which specific accounting server is handling said user and keeps a corresponding account (Ala-Laurila : Page 12 Line 1 – 9: (a) an accounting server of an external telecommunication network is considered as physically separated from said authentication/authorization server (b) the user identity is used to generate billing data and sending the billing data to the corresponding

accounting server).

As per claim 20, Ala-Laurila teaches requesting an accounting for said chargeable functionality from said indicated accounting server by said authentication/authorization client (Ala-Laurila : Page 15 Line 1 – 5: chargeable functionality such as the price of the service and the QoS of the service requested by the user must be further forward to the accounting server).

As per claim 21, Ala-Laurila teaches said authentication/authorization client receives a ticket indicating that said user has been granted to access said chargeable functionality, and said ticket is sent to said accounting server (Ala-Laurila : Page 15 Line 24 – 31).

As per claim 22, Ala-Laurila teaches said accounting server checks whether accounting for said user is to be started (Ala-Laurila : Page 18 Line 12 – 13).

As per claim 23, Ala-Laurila teaches said ticket contains at least one of the information of the group of: to which user it belongs, when the access was granted, for how long the access was granted, and from which client the access was granted (Ala-Laurila : Page 18 Line 5 – 30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ala-Laurila et al. (WO 10/76297 A1).

As per claim 18, Ala-Laurila teaches the method according to claim 14 and said accessing step is performed by sending an authentication/authorization request message from an authentication/authorization client to which said user is currently attached to said authentication/authorization server (Ala-Laurila : Page 7 Line 21 – 28). One skilled in the art would recognize that said authentication/authorization server which replies by sending an authentication/authorization answer message to said authentication/authorization client, and wherein said answer message includes said indication of said specific accounting server for said user (Ala-Laurila : Page 14 Line 20 – 23 and Page 2 Line 7 – 9) because Ala-Laurila teaches (a) authentication response message includes billing information (a) the user identity is used to generate billing data and sending the billing data to the corresponding accounting server and as such the billing information is obvious to include the information of selected accounting server).

As per claim 24, Ala-Laurila does not disclose expressly said ticket is signed by the authentication/authorization server so that it is verified to the accounting server that the authentication/authorization server really has made the ticket. Examiner notes Official Notice is taken that the use of digital signature is a well-known technology in the field. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use digital signature when exchanging messages between the authentication/authorization server and the accounting server.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Longbit Chai whose telephone number is 571-272-3788. The examiner can normally be reached on Monday-Friday 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Longbit Chai/

Longbit Chai Ph.D.
Patent Examiner
Art Unit 2131
6/22/2008